



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,801	12/19/2005	Jean-Francois Manen	27067/2012	7066

29932 7590 05/16/2007
SONNENSCHN NATH & ROSENTHAL LLP
FOR PAULA EVANS
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

SCHUBERG, LAURA J

ART UNIT PAPER NUMBER

1657

MAIL DATE DELIVERY MODE

05/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,801	Applicant(s) MANEN ET AL.	
	Examiner Laura Schuberg	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-16,21-34 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,7-14,33,34,39-49,52,53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15,16,21-32,50 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/17/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group II (claims 15-32) in the reply filed on 02/28/2007 is acknowledged. The traversal is on the ground(s) that the groups (now amended) share the special technical feature of a mixture of cell wall degrading enzymes isolated from a TW-1 mutant strain of *Trichoderma Longibrachiatum*. This is not found persuasive because a mixture of cell wall degrading enzymes isolated from *Trichoderma Longibrachiatum* Rifai is known in the art as described by Kasenkov (RU 2061003 C1, English translation-page 3). Since the reference, is referring to a microorganism of the same genus, species and subspecies as described by Applicant (page 8 line 23), the mixture of cell wall degrading enzymes is deemed to be structurally the same as claimed by Applicant (especially since Applicant is not claiming a specific concentration of the enzymes used).

The requirement is still deemed proper and is therefore made FINAL.

New claims 48-53 have been added.

Claims 1, 2, 7-16, 21-34, 39-53 are pending.

Claims 1, 2, 7-14, 33, 34, 39-49, 52, 53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 15, 16, 21-32, 50 and 51 have been examined on the merits.

Priority

It is noted that this application appears to claim subject matter disclosed in prior Application No. 60/434,699, filed 12/18/2002 as well as PCT/IB03/06422 filed 12/18/2003. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of

Art Unit: 1657

any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 16, 21-32, 50 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The invention appears to employ novel biological materials, specifically the TW-1 mutant strain of *Trichoderma Longibrachiatum* Rifai deposited as VKMF-3634D. Since the biological material is essential to the claimed invention it must be obtainable by a repeatable method set forth in the specification or otherwise readily available to the public.

It is noted that Applicant has deposited the biological material under the deposit number VKMF-3634D. If the deposit is made under the Budapest Treaty, then an affidavit or declaration by Applicant, or a statement by the attorney of record over his/her signature and registration number, stating that the biological materials will be released to the public irrevocably and without restriction or condition upon the issuance of a patent would satisfy the requirement. Further applicants must state that the deposit will be maintained for a period of 30 years, or five (5) years after the most recent request date, whichever is longer.

Claims 15, 16, 21-32, 50 and 51 are also rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for those plant species disclosed by Applicant (page 15 line 17- page 16 line 10), does not reasonably provide enablement for all plant species. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The factors to be considered in determining whether undue experimentation is required are summarized in *re Wands* 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988). The court in *Wands* states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (*Wands*, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction or guidance presented (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. While all these factors are considered, a sufficient number are discussed below so as to create a *prima facie* case.

The claims are drawn to a method of isolating DNA from plant tissue comprising: combining a sample of plant tissue with a mixture of cell wall degrading enzymes isolated from a TW-1 mutant strain of *Trichoderma longibrachiatum*, and incubating the tissue and mixture of enzymes. While the person of ordinary skill in the art would have a reasonable expectation of successfully practicing the method with plant species disclosed by Applicant, there would not be that reasonable expectation with each and every plant specie.

According to Manen et al (BMC Plant Biology 2005, page 5) there are quite a few species wherein the method as claimed is not effective which would require a large quantity of experimentation to overcome (see additional file 1 of reference). In addition, it is noted that the chemistry of plant tissues (contrary to animal tissues) is highly variable depending of species, which would also lead to a high level of unpredictability in the art (page 5).

Additionally, Applicant's have not provided any direction for modifying the method to accommodate plant species beyond those disclosed by Applicant. While lack of a working embodiment cannot be a sole factor in determining enablement, the absence of substantial evidence, in light of the unpredictable nature of the art and the direction applicants present, provides additional weight to the lack of enablement in consideration of the *Wands* factors as a whole. Thus one of ordinary skill in the art would not have a reasonable expectation of successfully isolating DNA from all species of plant tissues by performing the claimed method.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Schuberg whose telephone number is 571-272-3347. The examiner can normally be reached on Mon-Fri 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leon B. Lankford, Jr.
Primary Examiner
Art Unit 1651

Laura Schuberg